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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,060	11/22/2000	Hajime Nishihara	0216-0445P	2421

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,060

Applicant(s)

NISHIHARA, HAJIME

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 15-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1, 4 and 16 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the WO 99/28387 Patent.

US 6433050 is relied on as a translation.

The reference exemplifies (C18) a blend of PC, a silicone, PTFE and a sulfonic acid salt. The silicone of this example is a liner polymethyl phenyl siloxane of 50,000 MW.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 2/8/99. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claims 1, 4, 13 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J07196871 Patent.

The reference exemplifies (#1) a blend of polycarbonate, ABS, SAN, phosphate flame retardant, PTFE and TSF-437. TSF-437 is poly(methylphenylsiloxane). Uemura (col. 11, line 60) can be cited to confirm the identity of TSF-437.

Claims 1, 4, 5, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J09087504 Patent.

The reference exemplifies (#1-3) blends of PC, polycaprolactone and SH710. SH710 is a polymethylphenylsiloxane having a viscosity of 500 cst and 40% phenyl substituents (see Gokan col. 5, lines 36-38). Inherently SH710 must impart flame

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retardancey. Other flame retardants can be included (page 15 line 7) although amounts are not specified.

It would be a matter of routine experimentation to ascertain an appropriate amount of flame retardant. Applicant's amount (0.001-100) encompasses virtually any reasonable amount.

Claims 1, 4, 5, 13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J09083504 Patent in view of Katayama '016.

The primary reference does not name all useful flame retardants for his PC composition.

Katayama (col. 14 line 30 to col. 15 line 26) lists many phosphate and phosphite flame retardants for PC compositions.

It would have been obvious to use any of these well known flame retardants in the primary reference composition for the expected effect.

Claims 1, 4, 5, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J09087504 Patent in view of Bialous '935.

The primary reference does not name all useful flame retardants for his PC composition.

Bialous (table) shows that a combination of PTFE and sulfonic acid salt is effective to flame retard PC.

It would have been obvious to use PTFE and sulfonic acid salt as the flame retardant called for in J '504.

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Applicant's arguments filed 6/10/03 have been fully considered but they are not persuasive.

Applicant gives no clear explanation why J07196871 and J09087904 fail to suggest the current claims. The former actually employs a phosphate flame retardant along with the aromatic polysiloxane. The later clearly suggests inclusion of flame retardant to the PC + aromatic siloxane blend.

The declaration does not appear to address the rejections. The declaration shows the importance of using (1) polycarbonate as the matrix; and (2) a linear-aromatic siloxane. The primary references exemplify such limitations. The declaration merely confirms the good properties of the prior art blends.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/mn
July 28, 2003

